

REMARKS

Claims 1-16 are all the claims presently pending in the application. Claims 6 and 8 have been amended to more particularly define the invention. Claims 13-16 have been added to claim additional features of the invention.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1-3, 5, and 8-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over YAMAGUCHI, et al. (U.S. Patent No. 6,824,463 B1) in view of MORSCH (U.S. Patent No. 2,668,716). Claims 4, 6, and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over YAMAGUCHI, et al., in view of MORSCH, as applied to claim 1 above, and further in view of TOKITO, et al. (U.S. Patent No. 5,634,639). Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over YAMAGUCHI, et al., in view of MORSCH and TOKITO, et al., as applied to claim 4 above, and further in view of ISETANI, et al. (U.S. Des. 393,664).

These rejections are respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

The claimed invention is directed to a gaming machine including a cabinet having a face portion on which a lottery ball can roll and a plurality of lottery holes provided on the face portion, game result determination means for determining a game result under a condition that the lottery ball enters any one of the plurality of lottery holes of the cabinet, a

withdrawing passage being provided in the cabinet, the withdrawing passage being capable of allowing lottery balls having been discharged to pass through, lottery ball throwing means for allowing the lottery balls having been discharged from the plurality of lottery holes through the withdrawing passage to be thrown onto the face portion of the cabinet, and tilt control means for tilting the cabinet, wherein the cabinet is tilted by the tilt control means such that lottery balls having been located in the withdrawing passage are directed out to the lottery ball throwing means.

In conventional gaming machines, after a lottery ball enters a lottery hole, the lottery ball must be withdrawn so that the withdrawn lottery ball can be thrown in again, and thus a withdrawing mechanism for withdrawing lottery balls, etc., hinder simplification of gaming machines. (See Application at page 3, lines 5-7).

With the claimed invention, on the other hand, lottery balls may be withdrawn by tilting the cabinet and thus the gaming machine may be manufactured simply and at low cost. In particular, in a large-size gaming machine such as a bingo game or the like, it is required to further reduce the setup space of the gaming machine even if its reduction level is slight, and the claimed invention can further reduce the setup space. Furthermore, it may be unnecessary to provide the lottery ball discharging means to each of the plurality of lottery holes, and the gaming machine may be manufactured more simply at lower cost. (See Application at page 3, lines 4-12).

II. THE 35 USC §112, SECOND PARAGRAPH REJECTION

Claim 6 stands rejected under 35 U.S.C. §112, second paragraph. The claims have been amended, above, to overcome this rejection. Specifically, the claim has been amended to recite, “an open/close gate” and “a gate control means” to provide sufficient antecedent basis

for the limitations in the claim.

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this rejection.

III. THE 35 USC §101 REJECTION

Claim 8 stands rejected under 35 U.S.C. §101. Claim 8 has been amended, above, to overcome this rejection. Specifically, claim 8 has been amended to recite, "A computer-readable medium encoded with a computer program for a gaming machine."

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this rejection.

IV. THE PRIOR ART REFERENCE

A. The Rejections based on Yamaguchi and Morsch References

The Examiner alleges that Yamaguchi, when combined with Morsch, renders claims obvious. Applicant submits, however, that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention.

Claim 1 recites, "tilt control means for tilting the cabinet, wherein the cabinet is tilted by the tilt control means such that lottery balls having been located in the withdrawing passage are directed out to the lottery ball throwing means."

In contrast, as the Examiner concedes, Yamaguchi fails to teach or suggest the above-recited claim features. (Office Action, page 3, paragraph 8, line 13-page 4, lines 1-2). Morsch also fails to remedy Yamaguchi's deficiencies.

That is, Morsch teaches a game and amusement device where a post 12 and a bowl 10

are free to tilt back and forth about the axis of the shaft 15. The post 12 is tilted by means of an eccentric member 19 which is connected to the post 12 by an attachment clip 20. However, similar to Yamaguchi, Morsch fails to teach or suggest, “*wherein the cabinet is tilted by the tilt control means such that lottery balls having been located in the withdrawing passage are directed out to the lottery ball throwing means.*” That is, Morsch does not even teach or suggest a withdraw passage or a lottery ball throwing means. Morsch also does not teach or suggest that by having the eccentric member 19 tilt either the post 12 or the bowl 10, that a lottery ball may be directed to a lottery ball throwing means.

In *re Kahn* states that, “Rejection based on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F. 3d 977, 988. The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. ___, ___, 82 USPQ2d 1385, 1395-97 (2007) also identified a number of rationales to support a conclusion of obviousness which are consistent with the proper “functional approach” to the determination of obviousness as laid down in *Graham*. The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. The Supreme Court in *KSR* noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.

Exemplary rationales that may support a conclusion of obviousness include:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;

(D)Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E)“Obvious to try” – choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F)Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations are predictable to one of ordinary skill in the art;

(G)Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. (See MPEP 2143).

Here, the Examiner attempts to equate Yamaguchi’s number drawing apparatus 10, ball supply mechanism 2, and the supply unit 12 (that) includes a guide as the cabinet, the withdrawing passage, and the lottery ball throwing means of the current invention, respectively. (Office Action, page 3, paragraph 8). The Examiner then alleges that by combining the tilting of Morsch with Yamaguchi, the lottery ball delivered to the supply unit, the lottery ball delivered to the supply unit would be tilted and thrown on to the ramp. (Office Action, page 4, lines 4-7). However, the Examiner fails to explicitly and clearly articulate any rational underpinning that the claimed invention is obvious beyond conclusory statements.

That is, Yamaguchi shows that the ball supply mechanism 2 vertically carries the ball to the supply unit 12 by, for example an electric elevating mechanism, or by air pressure. (Figure 3; column 4, lines 54-57). However, Yamaguchi does not teach or suggest any desirability, or even feasibility, in tilting the number drawing apparatus 10, so that the ball carried by the ball supply mechanism 2 would benefit from tilting the drawing apparatus 10, or that its number drawing apparatus 10 may even be tilted. Indeed, to allow the ball to be

vertically carried from the ball supply mechanism 2 to the supply unit 12 by tilting, Yamaguchi's device would have to be turned upside-down, or the number drawing apparatus would have to be rotated more than 90 degrees from a horizontal plane. As a result, the ball will fall outside of Yamaguchi's device, rather than be directed to the supply unit 12, and will not be "thrown out" to the number drawing apparatus 10.

Also, Morsch fails to teach or suggest that tilting its post 12 and bowl 10 would direct a ball located in a withdrawing passage to be directed out to the lottery ball throwing means.

Even if there is some kind of rational underpinning to combine Yamaguchi with Morsch, the resulting device would merely be a tilting number drawing apparatus 10, without teaching or suggesting that the ball having been located in the ball-supply mechanism may be directed out to the supply unit 12 by mere tilting.

Although Yamaguchi also teaches a collecting and reuse unit, (Column 5, lines 40-45), Yamaguchi fails to show any structural arrangement for the unit, and does not teach or suggest that tilting the number drawing apparatus 10 may benefit the unit's collection and return of the balls to the ball-supply mechanism 2.

Claims 5 and 8 recite similar features.

Claims 5 and 8 additionally recite, "an open/close gate being provided between the withdrawing passage and the lottery ball accumulating means such that the open/close gate is opened/closed, ..., wherein the cabinet is tilted by the tilt control means such that the open/close gate is positioned on a lower side of the withdrawing passage, and the open/close gate is opened by the gate control means so that lottery balls located in the withdrawing passage are directed out to the lottery ball accumulating means."

In contrast, Yamaguchi teaches that a ball B may be dropped from a position above the rotating unit 11 without providing the supply unit 12. (Column 7, lines 50-55). However,

Yamaguchi fails to teach or suggest, “*an open/close gate being provided between the withdrawing passage and the lottery ball accumulating means such that the open/close gate is opened/closed.*”

Applicant points out that, “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present’ in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ ” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

Here, the Examiner attempts to equate Yamaguchi’s ball collecting mechanism 5 as the discharging means of the claimed invention. (Office Action, page 5, paragraph 11, lines 7-8). The Examiner then attempts equate the same ball collecting mechanism 5 as the open/close gate. (Office Action, page 5, paragraph 11, lines 16-18), and also attempts to equate Yamaguchi’s ball supply mechanism 2 as the withdrawing passage, and Yamaguchi’s collecting-and-reuse unit (not shown) as the ball accumulating means of the claimed invention, respectively. (Office Action, page 5, paragraph 11, lines 9-15). However, the Examiner does not show, and Yamaguchi does not teach or suggest, how Yamaguchi’s ball collecting mechanism 5 can be arranged between the ball supply mechanism 2 and the collecting-and-reuse unit (not shown). Indeed, Yamaguchi does not even teach or suggest where the collecting-and-reuse unit (not shown) is arranged with respect to the ball supply mechanism 2 and the ball collecting mechanism 5. Therefore, the Examiner has mischaracterized the ball collecting mechanism 5 as the open/close gate of the claimed invention. (Figure 3; column 5, lines 40-45).

Morsch also fails to remedy Yamaguchi’s deficiencies.

The Examiner does not even allege that Morsch teaches, “*an open/close gate being provided between the withdrawing passage and the lottery ball accumulating means such that the open/close gate is opened/closed.*” Instead, the Examiner merely alleges that Morsch teaches a means for tilting a housing back and forth about the axis of a shaft. (Office Action, page 6, lines 12 and 13. Therefore, even if Morsch and Yamaguchi may be combined, the combination would not teach or suggest each and every feature of the claimed invention.

Claim 9 recites, “*a swinging device for tilting the cabinet as the lottery balls roll over the face portion, wherein the cabinet is tilted such that lottery balls having been located in the withdrawing passage are directed out to the gate.*”

As the Examiner concedes, Yamaguchi fails to teach or suggest the above features recited by claim 9. (Office Action, page 9, paragraph 13, lines 13-15). Morsch also fails to remedy Yamaguchi’s deficiencies.

That is, Morsch teaches a game and amusement device where a post 12 and a bowl 10 are free to tilt back and forth about the axis of the shaft 15. The post 12 is tilted by means of an eccentric member 19 which is connected to the post 12 by an attachment clip 20. However, similar to Yamaguchi, Morsch fails to teach or suggest, “*wherein the cabinet is tilted such that lottery balls having been located in the withdrawing passage are directed out to the gate.*” That is, Morsch does not even teach or suggest a withdrawing passage, or a gate. Therefore, Morsch cannot teach or suggest that by having the eccentric member 19 tilt either the post 12 or the bowl 10, that a lottery ball having been located in the withdrawing passage are directed out to the gate.

The Examiner attempts to equate Yamaguchi’s number drawing apparatus 10, ball supply mechanism 2, and the ball-collecting mechanism 5 as the cabinet, the withdrawing passage, and the gate of the current invention, respectively. (Office Action, page 9, paragraph

13, lines 2-12). The Examiner then alleges that by combining the tilting of Morsch with Yamaguchi, the lottery ball delivered to the supply unit, the lottery ball delivered to the supply unit would be tilted and thrown on to the ramp. (Office Action, page 9-13, paragraph 13). However, the Examiner fails to explicitly and clearly articulate any rational underpinning that the claimed invention is obvious beyond conclusory statements.

Even if there is some kind of rational underpinning to combine Yamaguchi with Morsch, the resulting device would merely be a tilting number drawing apparatus 10, without teaching or suggesting that the ball having been located in the ball-supply mechanism 2 may be directed out to the ball-collecting mechanism 5 by mere tilting.

That is, Yamaguchi shows that the ball supply mechanism 2 vertically carries the ball to the supply unit 12 by, for example an electric elevating mechanism, or by air pressure. (Figure 3; column 4, lines 54-57). However, Yamaguchi does not teach or suggest any desirability, or even feasibility, in tilting the number drawing apparatus 10, so that the ball carried by the ball supply mechanism 2 can be directed to the ball-collecting mechanism 5 by tilting the drawing apparatus 10, or that its number drawing apparatus 10 may even be tilted. Indeed, to allow the ball to be vertically carried from the ball supply mechanism 2 to the supply unit 12 by tilting, Yamaguchi's device would have to be turned upside-down, or that the number drawing apparatus would have to be rotated more than 90 degrees from a horizontal plane. (See Figure 3). As a result, the ball will fall outside of Yamaguchi's device, rather than be directed to the ball-collecting mechanism 5, and will not be "thrown out" to the number drawing apparatus 10.

Since there are elements of the claimed invention that are not taught or suggested by either Yamaguchi or Morsch, the Examiner is respectfully requested to withdraw this rejection.

B. The Rejections Based on Yamaguchi, Morsch, and Tokito References

The Examiner alleges that Yamaguchi, when combined with Morsch, and Tokito, renders claims 4, 6, and 12, which depend on independent claims 1 and 9, obvious. Applicant submits, however, that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention.

As discussed previously, the combination of Yamaguchi and Morsch fails to teach or suggest, “tilt control means for tilting the cabinet, wherein the cabinet is tilted by the tilt control means such that lottery balls having been located in the withdrawing passage are directed out to the lottery ball throwing means.” as recited by claim 1, or “a swinging device for tilting the cabinet as the lottery balls roll over the face portion, wherein the cabinet is tilted such that lottery balls having been located in the withdrawing passage are directed out to the gate.” as recited by claim 9. Tokito also fails to remedy Yamaguchi’s and Morsch’s deficiencies.

That is, the Examiner does not even allege that Tokito teaches or suggests the above-recited features of claims 1 or 9. Instead, the Examiner merely alleges that Tokito teaches a method of determining the number of balls fed by a feeder by which the balls are delivered into the game. (Office Action, page 11, paragraph 17, lines 7 and 8).

Since there are elements of the claimed invention that are not taught or suggested by Yamaguchi, Morsch, or Tokito, the Examiner is respectfully requested to reconsider and withdraw this rejection.

C. The Rejections Based on Yamaguchi, Morsch, Tokito, and Isetami References

The Examiner alleges that Yamaguchi, when combined with Morsch, Tokito, and Isetami, renders claim 7, which depends on independent claim 1, obvious. Applicant submits,

however, that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention.

As discussed previously, the combination of Yamaguchi, Morsch, and Tokito fails to teach or suggest, “tilt control means for tilting the cabinet, wherein the cabinet is tilted by the tilt control means such that lottery balls having been located in the withdrawing passage are directed out to the lottery ball throwing means,” as recited by claim 1. Isetami also fails to remedy Yamaguchi’s, Morsch’s, and Tokito’s deficiencies.

That is, the Examiner does not even allege that Isetami teaches or suggests the above-recited features of claims 1. Instead, the Examiner merely alleges that Isetami teaches a game machine with the shape of a watercraft (a ship). (Office Action, page 13, paragraph 21).

Since there are elements of the claimed invention that are not taught or suggested by Yamaguchi, Morsch, Tokito, and Isetami, the Examiner is respectfully requested to reconsider and withdraw this rejection.

V. NEW CLAIMS

New claims 13-16 are added to claim additional features of the invention and to provide more varied protection for the claimed invention. Support for these claims can be found on at least page 61, lines 1-5 of the specification. The claims are independently patentable because of the novel and non-obvious features recited therein.

Claims 13-16 are patentable over any combination of the cited references at least based on similar reasons to those set forth above with respect to independent claims 1, 5, 8, and 9.

VI. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1-16, all the claims presently

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pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

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